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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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26304	7590	10/20/2004	EXAMINER	
KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK, NY 10022-2585			AMINI, JAVID A	
			ART UNIT	PAPER NUMBER
			2672	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/016,137	Applicant(s) MATSUURA ET AL.	
	Examiner Javid A Amini	Art Unit 2672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/27/03;11/25/03</u> . | 6) <input checked="" type="checkbox"/> Other: <u>PTO-1449 mail date: 04/07/04</u> . |

Response to Arguments

Applicant's arguments with respect to claims 1-3, 6 and 14 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments, see page 9 lines 2-4, filed July 09, 2004, with respect to the rejection(s) of claims 1-14 under 35 U.S.C. 102(e) and 103 have been fully considered and are persuasive.

Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Hinami et al. U.S. 6,681,57 B1 and Gasper et al. U.S. 5,689,618.

New ground of rejections:

Examiner changes the previous rejection of 35 U.S.C. 102(e) into 35 U.S.C. 102(b) and new rejection under 35 U.S.C. 112, first paragraph.

An explanation of the new rejections is following:

Applicant on page 9 lines 3-5 of remarks discloses that no new matter is introduced. Support may be found, at page 10 line 10, page 12 line 12 of Applicants' specification. Examiner's reply: Examiner could not find any support for the following phrases in specification, the currently amended phrases in the claims are: "a first object", "a second object" and "relatively moving".

The main reason of the new grounds of rejection is: The phrases, which amended the claims, could not be finding in the main prior art (Miller et al.). Therefore using another prior art that cited on previous office action dated March 19, 20004 to reject claims 1-3, 6, 12, 14 and 16-19 under 35 U.S.C. 102(b) as being anticipated by Hinami et al. And claims 4-5 rejected under 35 U.S.C. 103(a) as being unpatentable over Hinami et al., and further in view of Gasper et al.

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Clarification is required. Examiner suggests Applicant should be consistent with selecting Syllables. For example: Applicant uses the syllable "Judgment" in entire specification and in the claim 7 last line, claim 12 last line, and in claim 16 uses a "judgement" syllable.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1-19 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant in claims 1 and 6 in lines 3-4; in claim 6 lines 5 and 9; in claim 7 lines 4 and 10; and similar situation in claim 12-14 added terms "a first", "a second" and "relatively moving" which do not support in the specification. Examiner's comment: since the invention steps dependent on mentioned terms, therefore, it is essential to the practice of the invention, failure to recite or

~~include that particular feature or element in the claims may provide a basis for a rejection based~~

on the ground that those claims are not supported by an enabling disclosure. The written

description does not well establish the correlation between product of (refer to: the first/second object) and the function of (first/second display-control means for). Without such a correlation, the capability to recognize or understand the structure from the mere recitation of function and minimal structure is highly unlikely. Applicant on page 18 lines 13-23 describes the meaning of

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“selecting means for selecting” see following step: selecting means for selecting a set of one or more predetermined letters from a plurality of letters and forming a first object by adding a visual effect on the set of one or more predetermined letters, according to the information processing program; Applicant on page 8 lines 10-20 describes the meaning of “display-control means for” except the terms “first” and “second” see following step: first display-control means for displaying the first object and moving the first object together with one or more additional objects formed from the plurality of letters by scrolling the first object and the one or more additional objects; second display-control means for displaying a second predetermined object which is moved in accordance with operation by operating means on the displaying means. In claim 15 Applicant uses the term “state of motion” that does not specifically supported by the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6, 12, 14 and 16-19 rejected under 35 U.S.C. 102(b) as being anticipated by

Hinami et al. (hereinafter referred as a Hinami) U.S. 6,68,157 B1.

1. Claim 1.

Hinami in fig. 4 illustrates an execute a game and in fig. 3 shown the letter "A" (Examiner's interpretation: in claim 1 line 2 applicant claims “selecting a predetermined letter from a plurality of letters”, Hinami selects a predetermined letter as an letter “A” from a plurality of letters A and

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B see fig. 3) represents an example of the viewpoint (a viewpoint at a high altitude) for observing at a high altitude the first game field (or airplanes) and the second game field (or the ground).

The letter "B" in Fig. 3 represents an example of the viewpoint (a viewpoint at a low altitude) for observing at a low altitude only the second game field (or the ground). As described above, the viewpoint can move within the three-dimensional virtual space. An information processing method comprising the steps of: Selecting a predetermined letter from a plurality of letters.

Hinami in col. 14 lines 45-48 discloses that is possible to give a player a visual effect of causing the rain drops to seem falling toward and gathering at the center of the screen, which covers the following limitations: displaying a first object formed by adding a visual effect on the selected letter. Hinami in fig. 4 illustrates the following limitation of displaying a second predetermined object, see step S108. Hinami in fig. 4 step S110 illustrates an instruction such as "attack"

between the objects that follows the limitations of accepting a user's instruction for moving the second object. Hinami in col. 1 lines 61-65 discloses the game proceeded in a plurality of game fields simultaneously. It is possible to control each field by using separate algorithms and to independently set a time axis, a display scale or the like for indicating the progress of a game, which covers the following limitations of the present invention: relatively moving and displaying

the first and second object. Hinami in col. 1 lines 45-60 teaches a game device for proceeding a game by placing objects related to the game in a three-dimensional virtual space and by controlling the objects. The game device comprises: first game proceeding means (S102 and S104) for proceeding the game by controlling, the objects in a first game field in the three-dimensional virtual space; second game proceeding means (S106 and S108) for proceeding the game by controlling the objects in a second game field in the three-dimensional virtual space;

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and picture transformation display means (S5116) for forming a screen picture by transforming the coordinates of each object in the first and second game fields existing within view of a viewpoint located in the three-dimensional virtual space. See following limitations: comparing display positions between the first object and the second object after the step of relatively moving the first and second objects. Hinami in fig. 20 step S310 illustrates a possible judgment based on the previous steps. Therefore the functionality of these steps should cover the following claim language: making a judgment based on a result of the comparing step.

2. Claim 2.

Hinami in figs. 21 and 22 illustrates when the letter "S" represents a point where a straight line linking the viewpoint V1 with the upper edge of a virtual screen (or a plane of projection) SC intersects the map plane and the letter "T" represents the upper edge of the Map. Therefore the step of "wherein the plurality of letters is formed from a text data" is inherent because the letter "S" and "T" are text data.

3. Claim 3.

Hinami in fig. 6 illustrates forming pictures or as claim language claims (objects) and synthesizing the picture with the first field see fig. 8. The following step is inherent according to the claim language of "arranging the first object in a line with one or more additional objects formed from the plurality of letters, and scrolling the object together with the one or more additional objects arranged in the line". Also Hinami in col. 15 lines 51-59 teaches that the Hinami's invention is capable of shifting pictures (or viewpoints) from one game field to another game field and, therefore, is capable of easily expressing the correlation between the fields, for example, in the sky, on the ground, on the sea, under the ground and under the sea. Since it is

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possible to construct a game system for each game field, it is easy to have games of different algorithms, scroll speeds, game scales or the like coexist.

4. Claims 6, 12 and 14.

Hinami in col. 3 lines 58-60 discloses (Hinami's invention relates to an information storage medium with a program stored thereon, the program for activating a computer system as a game device) the preamble of the claim language in claim 6 "A storage medium having recorded therein an information processing program to be executed on a computer, wherein the information processing program comprising the steps of"; and the preamble in claim 14 "An information processing program to be executed on a computer, wherein the information processing program comprises the steps of". The preamble in claim 12 "A terminal device "

. See rejection of claim 1 for the rest of the limitations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-5 rejected under 35 U.S.C. 103(a) as being unpatentable over Hinami, and further in view of Gasper et al. (hereinafter referred as a Gasper), U.S. 5,689,618.

5. Claim 4.

Hinami in fig. 2 step 182 illustrates MPEG audio but silence to form letters from an audio data. Per claim language of "wherein the plurality of letters is formed from an audio data", however Gasper in fig. 1 step 9 illustrates audio input. Thus, it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to incorporate the teaching of Gasper into Hinami in order to the interface system provides a user with the capability to quickly and efficiently create advanced animated talking agents to provide an interface between users and computers. And prevents visual artifacts that are undesirable, such as pixellation.

6. Claim 5.

Hinami in fig. 2 step 182 illustrates MPEG audio but silence wherein the audio data is a musical sound. The step is obvious because audio input can be music data from a CD ROM drive see fig. 2 step 1b.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javid A Amini whose telephone number is 703-605-4248. The examiner can normally be reached on 8-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi can be reached on 703-305-4713. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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